

Docket No.: 081722-0080

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 83729
	:	
David W. Morris, et al.	:	Confirmation Number: 1189
	:	
Application No.: 10/692,382	:	Group Art Unit: 1637
	:	
Filed: October 22, 2003	:	Examiner: Kim, Young J.
	:	
For: NOVEL COMPOSITIONS AND METHODS IN CANCER	:	

RESPONSE TO ELECTION OF SPECIES

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being electronically-transmitted to the United States Patent and Trademark Office on December 17, 2008.

/Carrie Hines/

Carrie Hines

Sir:

Responsive to the Election of Species Requirement mailed October 17, 2008, Applicants respectfully request consideration of the following remarks.

REMARKS

Claims 49 and 55-73 are pending. Claim 49 is acknowledged to be generic. The Office alleges that the claims are directed to four distinct and independent species as follows:

Species i: colon cancer;
Species ii: breast cancer;
Species iii: prostate cancer, and
Species iv: stomach cancer.

Applicants traverse the Election of Species Requirement for the reasons below. In order to be responsive to the Office Action, Applicants elect Species i, directed to colon cancer. Claims 49 and 55-73 encompass the elected species. Upon allowance of a generic claim,

Applicants reserve the right to consideration of claims to additional species which depend from or otherwise require all the elements of an allowable generic claim.

Applicants traverse election of species requirement because, although the claimed species are patentably distinct, a thorough search of the elected species will include art relevant to the non-elected species. For example, the claims are directed to methods for diagnosing cancer comprising determining the expression of a cytochrome B5 gene. A thorough search and examination of cytochrome B5 expression will reveal art relevant to expression of cytochrome B5 expression in colon, breast, prostate and stomach cancer. Therefore, Applicants submit that search and examination of the entire application does not pose a serious burden to the Examiner. Reconsideration and rejoinder of all species for examination on the merits is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

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